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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,963	05/10/2001	Peter Van Giel	10015199-1	4094

7590 02/22/2005

HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

BELL, MELTIN

ART UNIT	PAPER NUMBER
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2121

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/851,963	Applicant(s) GIEL ET AL.	
	Examiner Mettin Bell	Art Unit 2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2004.  
2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.  
4a) Of the above claim(s) 1-23 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.  
7) ☒ Claim(s) 24-42 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 22 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

This action is responsive to application **09/851,963** filed **05/10/2001** as well as the Appeal Brief filed 12/10/2004. Claims 1-23 have been canceled as requested by the applicant. Claims 24-42 filed by the applicant have been entered and examined. An action on the merits of claims 24-42 appears below. Prosecution on the merits is reopened.

### ***Claim Objections***

Claims 24, 30, 31, 37, 38 and 42 are objected to because of the following informalities:

#### **Regarding claim 24:**

- 'to configuration' would read well as 'to analyze configuration'
- 'computerized' would read well as 'computer-implemented'

#### **Regarding claim 30:**

- 'to configuration' would read well as 'to analyze configuration'
- 'computerized' would read well as 'computer-implemented'

#### **Regarding claim 31:**

- 'to configuration' would read well as 'to analyze configuration'

#### **Regarding claim 37:**

- 'to configuration' would read well as 'to analyze configuration'

#### **Regarding claim 38:**

- 'to configuration' would read well as 'to analyze configuration'

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**Regarding claim 42:**

- 'to configuration' would read well as 'to analyze configuration'
- 'execution to in said' would read well as 'execution in said'

Appropriate correction is required.

***Allowable Subject Matter***

Claims 24-42 would be allowable if rewritten or amended to overcome the objection(s) set forth in this Office action. The following is a statement of reasons for the indication of allowable subject matter: The reason for allowance of the claims is the task definition comprising a list of analyzers for harnessing and analyzing configuration information from a list of computers. None of the cited references, and, in particular, *Weber* USPN 5,812,668, *Desgrousilliers et al* USPN 5,715,373, *Woods et al* USPN 6,748,451, *Kinser et al* USPN 5,790,633, *Davies et al* USPN 4,949,278, *Geddes* USPN 6,751,661, *Warr* USPN 5,131,087, *Griffin et al* USPN 6,442,714, *Horton et al* USPN 6,757,357 *Stewart et al* USPN 6,389,112, *Williamson et al* 6,577,711, *Frengut et al* USPAPN 2002/0046099, *Richards et al* USPAPN 2002/0099829 and *Amado* USPN 5,701,400, disclose this limitation upon further consideration. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

## RESPONSE TO APPLICANTS' AMENDMENT REMARKS

### ***Claim Rejections - 35 USC § 103***

Applicant argues that the *Desgrousilliers et al* patent is not relevant to the present invention as it relates to a very different area of technology – testing a program's requirements prior to writing the actual program (Appeal Brief REMARKS page 28, paragraph 1), the *Weber* patent is also not relevant to the present invention as it relates to a different area of technology – computerized secure payment transaction clearance methods and systems (Appeal Brief REMARKS page 30, paragraph 1), there is no motivation for one of ordinary skill in the art to combine the teachings of *Desgrousilliers et al* and *Weber* (Appeal Brief REMARKS page 31, paragraph 2), testing procedures taught in *Desgrousilliers et al* and *Weber* are carried out only on computers and software that are not operating normally in the field (Appeal Brief REMARKS page 34, paragraph 3), the claims considered individually element by element are patentable over the combination of *Desgrousilliers et al* and *Weber* (Appeal Brief REMARKS page 36, paragraph 3) and claims 24 to 42 are not rendered obvious by the combination of the *Desgrousilliers et al* and *Weber* patents (Appeal Brief REMARKS page 79, paragraph 1). Applicant's arguments have been fully considered and are persuasive. The 35 USC 103(a) rejections of claims 24-42 are withdrawn.

**Conclusion**

The prior art made of record is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the Office should be directed to Meltin Bell whose telephone number is 571-272-3680. This Examiner can normally be reached on Mon - Fri 7:30 am - 4:00 pm.

If attempts to reach this Examiner by telephone are unsuccessful, his supervisor, Anthony Knight, can be reached on 571-272-3687. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MB / *M.B.*  
February 16, 2005

  
**Anthony Knight**  
**Supervisory Patent Examiner**  
**Group 3600**